



30 SEP 2003

UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENTS
UNITED STATES PATENT AND TRADEMARK OFFICE
P.O. Box 1450
ALEXANDRIA, VA 22313-1450
www.uspto.gov

Kendall I. Thiessen
Gibson, Dunn & Crutcher, LLP
1801 California Street, Suite 4100
Denver, CO 80202

In re Application of	:	DECISION ON
BOND, Anthony Wayne, et al.	:	
Application No.: 09/743,950	:	PETITIONS UNDER
PCT No.: PCT/AU99/00595	:	
Int. Filing Date: 23 July 1999	:	37 CFR 1.47(a)
Priority Date: 24 July 1998	:	
Attorney Docket No.: 3135/FBR	:	AND
For: INPUT/OUTPUT INTERFACE AND	:	
DEVICE ABSTRACTION	:	37 CFR 1.137(b)

This is a decision on applicants' "Petition to Revive Unintentionally Abandoned Application Under 37 CFR §1.137(b)," filed in the United States Patent and Trademark Office (USPTO) on 28 July 2003.

BACKGROUND

On 23 July 1999, applicants filed international application PCT/AU99/00595, which claimed a priority date of 24 July 1998. A copy of the international application was communicated to the United States Patent and Trademark Office (USPTO) from the International Bureau on 10 February 2000. A Demand for international preliminary examination, in which the United States was elected, was filed on 24 February 2000, within nineteen months from the priority date. Accordingly, the thirty-month period for paying the basic national fee in the United States expired at midnight on 24 January 2001.

On 12 January 2001, applicants filed a submission for entry into the national stage in the United States which was accompanied by, *inter alia*, the U.S. Basic National Fee.

On 23 February 2001, the USPTO mailed a Notification of Missing Requirements (Form PCT/DO/EO/905) indicating, *inter alia*, that an oath or declaration of the inventors in compliance with 37 CFR 1.497(a)-(b) was required.

On 30 May 2002, the Office mailed a Notification of Abandonment (Form PCT/DO/EO/909) indicating the application went abandoned for failure to timely reply to the Notification of Missing Requirements filed 23 February 2001.

On 23 July 2002, applicants submitted the initial petitions under 37 CFR 1.137(b) and 37 CFR 1.183, which were accompanied by a statement from Shahan Islam.

On 09 September 2002, the Office mailed Decision On Petitions Under 37 CFR 1.183 and 37 CFR 1.137(b) dismissing applicants' petitions without prejudice. The decision set a two (2) month period for reply, running from the mail date of the decision. Extensions of time were available under 37 CFR 1.136(a).

On 28 July 2003, applicants filed a second petition to revive, along with a petition under 37 CFR 1.47(a).

DISCUSSION

A petition to revive an abandoned application under 37 CFR 1.137(b) must be filed without intentional delay from the time the application became abandoned and/or applicant first became aware of the abandoned status of the application. A petition under 37 CFR 1.137(b) must be accompanied by (1) a statement that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition was unintentional, (2) the required reply, (3) the petition fee required by law (37 CFR 1.17(m)), and (4) a terminal disclaimer and fee (if the international application was filed prior to June 8, 1995). Pursuant to 37 CFR 1.137(b)(3), additional information may be required where there is a question whether the delay was unintentional.

Items (2), (3) and (4) have been satisfied. The proper reply is a petition under 37 CFR 1.47(a). It is discussed below.

Item (1) has not been satisfied. While the required statement has been provided, additional information explaining the delay is now required. Specifically, applicants must provide a more detailed explanation of the lengthy delay in filing second petition to revive, as the entire delay must be unintentional for the application to be revived. Applicants must explain the original delay in filing an appropriate response (namely an executed declaration or a 37 CFR 1.47 petition) that resulted in the abandonment of the application, the delay in filing the first petition to revive and the delay in filing the appropriate reply (a 37 CFR 1.47(a) petition) with that petition, and the delay in filing the second petition to revive. MPEP 711.03(c)(III)(D). In particular, the Office wants to know where these files were located throughout this time (were they located at the original firm, did they remain in the custody of the firm or were they in the custody of applicants), when did the various attorneys become aware of the abandonment of the application, when did the applicants become aware of the abandonment and what provisions did the various attorneys have in place to track applications and their due dates, to prevent abandonments. Copies of documentary evidence that support the contention that the entire delay was unintentional should be submitted.

Petition Under 37 CFR 1.47(a)

A petition under 37 CFR 1.47 must be accompanied by: (1) the fee under 37 CFR 1.17(h), (2) proof of pertinent facts, namely that the inventor refuses to sign or cannot be reached after diligent effort, (3) a statement of the last known address of the inventor, and (4) an oath or declaration by the 37 CFR 1.47(a) applicant on behalf of himself or herself and the nonsigning applicant.

Items (1), (2), (3) and (4) appear satisfied. The fee has been paid. Applicants have furnished evidence of their inability to locate the nonsigning inventor after a diligent effort. Applicants list the address of Mr. Ronald Mach, the non-signing inventor, as 7942 Wishing Well Road; Las Vegas, NV 89123. The declaration complies with 37 CFR 1.497(a)-(b) and 37 CFR 1.47.

Upon cursory review, the petition under 37 CFR 1.47(a) appears to satisfy 37 CFR 1.47(a). A decision on the petition is held in abeyance until the application is properly revived.

CONCLUSION

For the above reasons, applicants' petition under 37 CFR 1.137(b) is **DISMISSED**, without prejudice.

A decision on petition under 37 CFR 1.47(a) will be provided when the application is properly revived.

The application remains **ABANDONED**.

If reconsideration on the merits of this petition is desired, a proper response must be filed within TWO (2) MONTHS from the mail date of this decision. Any reconsideration request should include a cover letter entitled "Renewed Petition Under 37 CFR 1.137(b)."

Any further correspondence with respect to this matter should be addressed to the Mail Stop PCT, Commissioner for Patents, Office of PCT Legal Administration, P.O. Box 1450, Alexandria, Virginia 22313-1450, with the contents of the letter marked to the attention of the Office of PCT Legal Administration.



Richard Cole
PCT Legal Examiner
PCT Legal Administration



Erin M. Pender
Attorney Advisor
PCT Legal Administration

Telephone: 703-305-0455
Facsimile: 703-308-6459